

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claims 2-6 and 9-55 are allowed.

However, the Examiner has rejected claims 7 and 8 under 35 U.S.C. § 102(b) as being anticipated by JP 04-000409 to Iwasaki (hereinafter "Iwasaki"). The Examiner also rejects claim 1 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,120,953 to Harris (hereinafter "Harris").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below.

With regard to the Iwasaki reference, Applicants respectfully submit that the same does not disclose the features of claims 7 and 8. Applicants can find no mention in the Abstract or in the Figures of the Japanese version of Iwasaki of the tip cover glass being at an angle that is not perpendicular to the optical axis (claim 7). Similarly, Applicants can find no mention in the Abstract or in the Figures of the Japanese version of Iwasaki where the scanners are structured such that their optical axes are perpendicular to the cover glass (claim 8).

In the Japanese version of Iwasaki, there is described "The reverse light optical system 18 and the received light optical system 21 are fixed while having their optical axes match each other" at the left upper part on page 3 lines 5 to 10 and "the moving table 15 is fixed in the state in which the optical axis of the optical system 18 is perpendicular" at the left lower part on page 7 lines 7 to 9. However, neither the former description nor the latter description in Iwasaki refers to the tip cover glass having an angle that is not perpendicular to

the optical axis (as set forth in claim 7) or the scanners' optical axes being perpendicular to the cover glass (as set forth in claim 8).

With regard to the rejection of claims 7 and 8 under 35 U.S.C. § 102(b), an optical scanning probe device having the features discussed above and as recited in independent claims 7 and 8, are nowhere disclosed in Iwasaki. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claims 7 and 8 are not anticipated by Iwasaki. Accordingly, independent claims 7 and 8 patentably distinguish over Iwasaki and are allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 7 and 8 under 35 U.S.C. § 102(b).

With regard to the Harris reference, the Examiner admits that the same is silent as to a recognition component but that the same would have been obvious to automatically recognize the attached component and adjust the optics accordingly. The Applicants respectfully disagree. The Examiner does not combine Harris with another reference to make up for the deficiency of Harris. Therefore, the Examiner argues that the missing features would be obvious from Harris to those of ordinary skill in the art at the time of the invention. However, Applicants see no suggestion in Harris itself, which would motivate a person skilled in the art to add the missing features. Harris provides no motivation or suggestion to use a detachable connector in which the type of attached component is recognized and the optics adjusted accordingly. Furthermore, where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Although Harris discloses that two identical microscopes (in view of “the same reference numerals” provided) are alternately used to observe as shown in Fig. 12, Harris neither discloses nor suggests the features of claim 1 of the present application, i.e., “a mounting component for detachably mounting at least one of a plurality of types of optical scanning probes...”, “a recognition component for recognizing the type of optical scanning probe...” and “a control device for controlling the scanning component ... according to the optical scanning probe recognized by the recognition component”.

Independent claim 1 is not rendered obvious by the cited reference because the Harris patent, whether taken alone or in combination with the knowledge of one of ordinary skill in the art, does not teach or suggest an optical scanning probe system having the features described above. Accordingly, claim 1 patentably distinguishes over the prior art and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized flourish at the end.

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